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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/403,796	10/25/1999	MUMTAZ SHAH		7704

7590 04/06/2004  
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EXAMINER

GOODMAN, CHARLES

ART UNIT PAPER NUMBER

3724

22

DATE MAILED: 04/06/2004

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 22

Application Number: 09/403,796  
Filing Date: October 25, 1999  
Appellant(s): SHAH, MUMTAZ

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Edwin D. Schindler  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed August 8, 2003.

**(1) *Real Party in Interest***

**MAILED**  
**APR 06 2004**  
**GROUP 3700**

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A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

No amendment after final has been filed.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

The rejection of claims 20-24 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

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3,835,536	MARCOUX	09-1974
3,068,569	CAMPBELL, JR.	12-1962

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 20-22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Marcoux in view of Campbell Jr..

Marcoux, in the embodiments shown in Figs. 8-11, discloses the invention substantially as claimed including, inter alia, a freely movable unit (Fig. 8); an upper part (e.g. 21); a lower part (e.g. 27); and a cutting blade (22). However, Marcoux lacks a pressure means. In that regard, Campbell Jr. teaches a cutter having a pressure means or roller (17) disposed immediately in front of a cutting blade (14) for the purpose of placing the sheet material to be cut under tension immediately in front of the cutter. See Figs. 2-5, c. 3, ll. 5-37. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the device of Marcoux with the pressure means as taught by Campbell Jr. in order to facilitate enhanced tensioning of the sheet material during cutting.

Claim 23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Marcoux in view of Campbell Jr. as applied to claims 20-22 above, and further in view of Shah (GB 2,223,976).

The modified device of Marcoux discloses the invention substantially as claimed including substantially matching faces that facilitate sinusoidal shaping of the material to be cut and thereby provide tension, the sinusoidal shape defined by the arc. See e.g. Fig. 11. However, if it is argued that Marcoux lacks this feature, then Shah teaches a

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cutting device comprising upper and lower parts (3, 2) having matching sinusoidal faces (Fig. 6) which enhances tensioning of sheet material 1 to be cut. See Fig. 6, p. 4, ll. 6-15. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the modified device of Marcoux with the sinusoidal matching faces as taught by Shah in order to facilitate tensioning of the sheet material to be cut.

Claim 24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Marcoux in view of Campbell Jr. as applied to claims 20-22 above, and further in view of Li.

The modified device of Marcoux discloses the invention substantially as claimed except for a window. However, Li teaches a window (the cut out portion above 24 in Fig. 1) which inherently serves as a means to visually observe the cutting action or the line of cut. See Fig. 1. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the modified device of Marcoux with the window as taught by Li in order to facilitate proper alignment and cutting of the sheet material.

### **(11) Response to Argument**

In response to Appellant's basic argument that Marcoux does not disclose the invention substantially as claimed because Marcoux allegedly is not a unit that is freely movable in both linear and non-linear paths,<sup>1</sup> this argument is traversed.

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<sup>1</sup> Brief, p. 7, l. 18 - p. 10, l. 9.

Initially, it is noted that the Appellant's argument in the previous Brief, Paper No. 19, pp. 10-15, traversing *Ex parte Marsham* is not applicable in the current brief to the extent that a new grounds of rejection had been set forth in the last Office Action.

First, the Examiner acknowledges that Marcoux's invention is intended to be generally used for linear cuts. However, based upon the structure of the cutting apparatus in the embodiment of Figs. 8-11 in comparison with the Appellant's disclosure and drawings, the Examiner cannot agree that Marcoux's invention is not capable of performing non-linear cuts. The relevant portion of independent claim 20 calls for a "unit freely movable in both linear and non-linear paths..." The phrase "freely movable" in the Examiner's view relates to intended use because of what is shown in Figs. 1-3 of the Appellant's disclosure. The unit (10) may be moved in any direction due to the fact that the unit has no guide. In other words, the user defines the path in which the unit may move. Similarly, Figs. 8-10 in Marcoux show and teach a stand alone unit (e.g. 21) that may (not must) be used in conjunction with a ruler or straight edge (20) to perform a straight cut. If not, then the device is fully capable of movement in any path the user desires.

Second, concentrating more on the claims, claim 22 may be summarized as requiring (1) a freely movable unit having a lower part; (2) an upper part which together with the lower part define a gap; (3) a cutting blade extending across the gap; and (4) pressure means. Besides the lacking pressure means, Marcoux includes a freely movable unit (Fig. 8); an upper part (e.g. 21); a lower part (e.g. 27); a gap (at 28); and a cutting blade (22). Notwithstanding the weight of the functional language of "freely movable", which in the Examiner's opinion is *de minimus*, the claim does not set forth

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any particular features that allows for that type of movement, i.e. what specific feature of the unit allows for free movement? Based upon the drawings in the application as well as the specification, the main feature that one skilled in the art may glean as allowing this movement is simply the fact that the device is not using any guides, i.e., it is a hand manipulated cutter without using a straight or curved edge as a guide. Similarly, Marcoux's invention of Figs. 8-11 is a hand manipulated cutter that may or may not be used with a guide.

Third, the Appellant argues that the pair of straight edges (23, 24) in Marcoux et al purportedly compel linear movement of Marcoux's device with or without a ruler.<sup>2</sup> However, this is not clearly understood to the extent that it is not clear how Appellant's own invention claimed or disclosed is markedly different from Marcoux so that the same cannot be said of Appellant's invention. It is affirmed that Marcoux includes those edges. Similarly, Appellant's own invention includes a pair of substantially parallel opposite sides below references (12) and (10) in Fig. 1. Thus, if parallel sides induces one skilled in the art to only move the device in a linear direction as the Appellant seems to argue, then the same reasoning applies to Appellant's invention. Again, the question arises what unique features claimed or otherwise permits Appellant's invention to move in both linear and non-linear paths? Again it appears to be in the discretion of the user.

In response to Appellant's basic argument that Campbell Jr. is nonanalogous art,<sup>3</sup> it has been held that a prior art reference must either be in the field of Appellant's endeavor or, if not, then be reasonably pertinent to the particular problem with which

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<sup>2</sup> Id., p. 9, l. 13 - p. 10, l. 9.

<sup>3</sup> Id., p. 10, l. 10 - p. 11, l. 6.

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the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

In this case, Campbell Jr. is fully analogous art because Campbell Jr.'s invention is within the field of Appellant's endeavor, mainly a manual device to cut sheet material.

The Examiner has addressed this issue many times with the Appellant, and for space considerations, the Board's attention is respectfully directed to the comments the

Examiner made in Office Action, Paper No. 11, pp. 7-10. As a matter of note, the

Examiner's comment that Appellant's argument on this issue as lacking merit is due to the fact that the Appellant had not set forth any new points at that time. Moreover, the

Appellant's arguments raised issues that were not relevant to the applied teachings of Campbell Jr. Most importantly, the Appellant argues that Campbell Jr.'s device is not

"freely movable." On the one hand, it is irrelevant due to the fact that the applied

teachings related to the pressure means as being an obvious feature because the pressure means as taught by Campbell Jr. places the sheet under tension and thereby

provide an easier cut. See Campbell Jr., c. 3, ll. 32-37. On the other hand, Campbell

Jr.'s device need not be "freely movable" because this is already inherent in the device of

the primary reference, Marcoux. Moreover, even Campbell Jr.'s device is capable of

moving in non-linear paths because, again, Campbell Jr.'s device and teaching are fully

analogous, it is a manually manipulated device, and the path in which the device travels depends on the whims of the user. For example, if a user desires to cut an edge portion

of a circular sheet, then it would not require much dexterity to manipulate Campbell

Jr.'s device to achieve this result. Even in the current Brief, the Appellant has not set

forth any substantive arguments as to why Campbell Jr. is not analogous.



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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


cg

April 5, 2004

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